

REMARKS

Applicant respectfully requests reconsideration of the present U.S. Patent application. Claims 1, 6, 11 and 16 have been amended. No claims have been canceled or added. Thus, claims 1-20 remain pending.

Request to Withdraw Finality

Applicant respectfully requests that the Examiner withdraw the finality of the Office Action mailed February 15, 2002 (the Second Office Action).

In the Office Action mailed November 6, 2001 (the First Office Action), the Examiner states "Claims 1-20 rejected under 35 USC 102(b) as being clearly anticipated by [U.S. Patent No. 4,835,372 issued to] Gombrich et al." In the Second Office Action, the Examiner states that "a reference which clearly anticipates the claims needs no further reference" (emphasis in original). However, the only reference to the "clearly anticipated" standard found by the Applicant in the MPEP appears in MPEP Section 706.02(i). MPEP Section 706.02(i) states that

The following form paragraphs should be used in making the appropriate rejections.

Note that the particular part of the reference relied upon to support the rejection should be identified.

(emphasis added). Paragraph 7.15 ("Claims [1] rejected under 35 U.S.C. 102[2] as being [3] by [4]") appears to be the form paragraph the Examiner used in rejecting Claims 1-20 in the First Office Action. The Examiner Note for Paragraph 7.15 states "in bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph" (emphasis added). In the First Office Action, the Examiner neither identified the particular part of the reference relied upon to support the rejection nor provided an

explanation of why the claims were clearly anticipated by U.S. Patent No. 4,835,372 issued to Gombrich et al. (*Gombrich*). In the Second Office Action, the Examiner identified the particular part of *Gombrich* relied upon to support the rejection for Claim 1 only.

On a second examination by an examiner, a rejection may be made final. See 37 CFR 1.113. However, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” See MPEP § 706. Examiner’s failure to identify the particular part of *Gombrich* relied upon to support the rejection in the First Office Action deprived the Applicant of the opportunity to provide evidence of patentability or otherwise reply completely to the First Office Action. Because the Second Office Action provided the Applicant’s first opportunity to provide evidence of patentability or otherwise reply completely to a rejection of Claim 1, the Applicant respectfully requests that the Examiner withdraw the finality of the Second Office Action.

#### Claim Rejections - 35 U.S.C. § 102

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4,835,372 issued to Gombrich et al. (*Gombrich*). For at least the reasons set forth below, Applicant submits that claims 1-20 are not anticipated by *Gombrich*.

Amended Claim 1 recites the following:

providing access to a set of products available for electronic ordering by a user; monitoring products ordered by the user; and providing, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user.

Amended Claim 6 is drawn to a machine-readable medium storing sequences of instructions, and recites similar limitations. Amended Claim 11 is an apparatus claim written in means-plus-function language, and recites similar limitations.

*Gombrich* discloses a staff person receiving a prescription for a patient, accessing a list of drugs in a computer system after scanning the patient's identification bar code, and entering drug dosages and frequency of administration. See col. 14, lines 40-47. The staff person places a patient identification bar code label on the prescription and sends the prescription to the pharmacy for filling. See col. 14, lines 61-64. A pharmacist scans a patient's identification bar code to access the patient's file at the pharmacy terminal and checks the computer data against the prescription. See col. 14, line 65 – col. 15, line 1. In addition, a bar code reading device stores a record of the most recently dispensed drug administered to control pain. See col. 16, lines 49-53. A computer system automatically records in a patient billing file a drug dispensed to a patient. See col. 17, lines 31-34.

*Gombrich* does not disclose providing, automatically, in response to subsequent accesses by a user a list of products previously ordered by the user. Therefore, *Gombrich* does not anticipate the invention as claimed in claims 1, 6 and 11.

Claims 2-5 depend from claim 1. Claims 7-10 depend from claim 6. Claims 12-15 depend from claim 11. Because dependent claims include the limitations of the claims from which they depend, Applicant submits that claims 2-5, 7-10 and 12-15 are not anticipated by *Gombrich* for at least the reasons set forth above.

Amended Claim 16 recites the following:

A networked server device to provide information related to products available for ordering by a user of a client device coupled to the server, the server device to monitor products ordered by users that access the server device and to record products ordered by the users, wherein the server device provides one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.

As discussed above in connection with Claims 1, 6 and 11, *Gombrich* does not disclose providing one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.

Therefore, *Gombrich* does not anticipate the invention as claimed in claim 16.

Claims 17-20 depend from claim 16. Because dependent claims include the limitations of the claims from which they depend, Applicant submits that claims 17-20 are not anticipated by *Gombrich* for at least the reasons set forth above.

### CONCLUSION

For at least the foregoing reasons, Applicant submits that the Examiner's rejections have been overcome. Therefore, claims 1-20 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Examiner K. Rice  
Art Unit 2167

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VERSION OF CLAIMS MARKED TO SHOW CHANGES

1. (Amended) A method comprising:

providing access to a set of products available for electronic ordering by a user;

monitoring products ordered by [a] the user; and

providing, automatically, [to the user access to] in response to subsequent accesses by the user a list of products previously ordered by the user.

6. (Amended) A machine-readable medium having instructions stored thereon to implement an electronic commerce World Wide Web page, the sequences of instructions, when executed by one or more processors, cause one or more electronic systems to:

provide access to a set of products available for electronic ordering by a user;

monitor products ordered by [a] the user; and

provide, automatically, [to the user access to] in response to subsequent accesses by the user a list of products previously ordered by the user.

11. (Amended) An apparatus comprising:

means for providing access to a set of products available for electronic ordering by a user;

means for monitoring products ordered by [a] the user; and

means for providing, automatically, [to the user access to] in response to subsequent accesses by the user a list of products previously ordered by the user.

16. (Amended) A networked server device [comprising] to provide information related to products available for ordering by a user of a client device coupled to the server, the server device to monitor products ordered by users that access the server device and to record products ordered by the users, wherein the server device provides one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.